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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,694

11/17/2003

Lowell R. Wedemeyer

CheekAir

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EXAMINER

JACKSON, BRANDON LEE

ART UNIT

PAPER NUMBER

3772

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,694	Applicant(s) WEDEMEYER, LOWELL R.	
	Examiner BRANDON JACKSON	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 33-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to amendments/arguments filed 11/26/2007.

Currently, claims 33-43 are pending in the instant application.

Response to Arguments

Applicant's arguments filed 11/26/2007 have been fully considered but they are not persuasive. Applicant argues Leal's tabs (32, 34) would not contact the teeth of the user, however, the intended use is for the user's teeth not to contact the tabs; but it would be obvious that one's teeth could be able contact the tabs, depending on the size and placement of the device. Moreover, Leal's device could be compressed by the lips of the user or by the compression of the jaw when the user's closes his/her mouth.

Applicant argues the Examiner incorrectly asserts that Applicant has not claimed that the claimed invention is compressed by the soft tissue of the user's mouth. However, Applicant merely claims the invention is adapted to compress as the user's jaw closes and expand as the user's jaw expands.

Applicant argues the Examiner has improperly disregarded a closed limitation of sized to fit within one of a user's cheek pouches. Applicant has not claimed only one cheek pouch; a device can be sized to fit within one cheek pouch while simultaneously fitting into another cheek pouch.

Applicant argues one of ordinary skill would not have the motivation to bend the wires of the Leal device in order to adjust the span size. However, the Leal device is formed by the bending of wires in order to form a particular size and shape to fit a user

for a dental procedure. The mouths of different patients are not identical, therefore dental devices of different sizes and configurations are needed in order to best fit each individual patient. In order to form dental devices that conform to the contours of different user's mouths one would have to bend device into a specific size and shape to fit the user. Therefore it would be obvious to one of ordinary skill in the art to bend the wires of the Leal device in order to better fit the user.

Applicant argues the Leal device would be malfunctioning if the user could compress the device with the soft tissue of the mouth because it may cause the user pain during compression. Applicant has provided no evidence that the pain would be caused by the user's compressing the device with the soft tissue of the mouth; moreover, because a process may cause a user pain or discomfort does not mean the device is not capable of performing the process or that the device is malfunctioning by performing the process. Pain and discomfort are many times associated with dental devices and procedures, however, these procedures and devices are still used.

Applicant argues the examiner has insufficient foundation for the assertion that Leal's whole wire remains resilient after Leal attached other elements to the wire. The attachment of other elements to the wire would not change the resiliency. The Leal device is intended to be a resilient device in order to hold the user's mouth in an open position and therefore would remain resilient with other elements are attached to the device that assist in the dental procedure. Figures 2 & 5 show other elements attached to the wire device, and the device remains resilient.

Applicant does not argue the Leal device can have the wires bent to form different sizes and shapes. However, Applicant does argue the adjustments could be cumbersome, maybe not the best way to adjust the device, and maybe not necessarily the best way to adjust the device for different shaped mouths. Even though a process may not be the easiest and most effective way to accomplish a goal does not mean that it is not capable of it. As Applicant admits, the Leal device is capable of having the wires bent to adjust the span size and therefore the Leal device reads on Applicant's claims because it is capable of having the wires bent that would result in an increase or decrease in the loop span size.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33- 36 and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Leal (U.S. Patent 5,199,872). Leal discloses a cheek anchor device (10) for maintaining mouth position (col. 1, lines 64-66), comprising a spring element (40) adapted to be placed in the cheek pouch, compressed when the jaw is closed, and to resiliently expand to open the mouth during a procedure (col. 1, lines 7-12). The “adapted to ...” language has not been considered since it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation,

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but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Moreover, the Leal device is fully capable of being placed in a cheek pouch, compressed when the jaw is closed, and resiliently expand when the mouth is opened. The device (10) has a conduit col. 4, lines 56-63) for fluid. Examiner has given the term conduit its broadest, most reasonable definition, which is an element with a hole therethrough that can transfer air of fluid, which is the cotton surround the spring element (40). The device (10) is formed of metal (col. 1, lines 52-55) and configured into a plurality of loops (fig. 1), wherein if one loop has its span increased or decreased it will result in another loop increasing or decreasing span because the device is made of continuous pieces of wire. The plurality of loops is combined to form a spring element (40) with an element span size (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 37-38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leal (U.S. Patent 5,199,872) in view of Diaz (U.S. Patent 4,041,937). Leal substantially discloses the claimed invention, see claim 33 rejection above, Leal fails to disclose the spring element is adapted to receive impregnation or coating with a substance to be released in the user's mouth. However, Diaz teaches cotton swab (28a) moistened with antiseptic (col. 1, lines 58-61). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to coat the cotton of the Leal device with antiseptic to prevent infection in the mouth and provide a pleasant taste to the user. The "adapted to ..." language has not been considered since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/
Examiner, Art Unit 3772

BLJ

/LoAn H. Thanh/
Supervisory Patent Examiner, Art Unit 3764

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